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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,570	08/14/2000	Roger William Gutwein	7721M	9947

27752 7590 01/25/2005

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EXAMINER

WEIER, ANTHONY J

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,570

Applicant(s)

GUTWEIN ET AL.

Examiner

Anthony Wei r

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 6 and 9-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 5, 6, and 9-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5, 6, and 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, said claims are drawn to both an apparatus and the method steps of using the apparatus. Such claims are considered to be directed to neither a process nor a machine, but instead overlap two different statutory classes of invention within a single claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 6, and 9-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, said claims are directed to an apparatus and the method steps of using same wherein it is not clear whether the claims are intended as apparatus claims or method claims, and if considered apparatus claims same are not directed to limitations regarding the structure of same. In *Ex parte Lyell*, 17 USPQ2d 1548.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Adler.

Adler discloses a method which provides a choice of drinks to be chosen by the consumer including coffee, coffee with cream, coffee with sugar, etc. by using a vending machine (col. 2, lines 45-52). The vending machine of Adler is disclosed to hold coffee in the form of a concentrate (Applicants own specification describes the extract used as a “concentrate” , page 11, second paragraph) wherein said concentrate is diluted with hot water when a coin is inserted into the machine and a choice of coffee beverage is made. Adler’s invention is concerned with preserving the liquid coffee and other ingredients of the vending machine by using vacuum storage and wherein “materials may be kept in the machine over extended periods of time” (col. 2, lines 18 and 19). Although not specifying a particular time, it is considered inherent that “extended period of time” would be well beyond a 5 minute (or even 30 minute) interval of storage and that the apparatus of Adler would be able to perform in such manner. It should be further noted that Adler inherently provides a method of controlling dilution as the user of the apparatus is able to adjust the amount of water or other ingredients added such that said apparatus provides the desired amounts and combinations envisioned.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al.

If it is shown that by “extended time”, Adler et al is referring to use of an apparatus which may only operate at a time range of less than 5 minutes, it would have been obvious to one having ordinary skill in the art to have modified the apparatus of Adler et al to allow same to be able to provide a method step such that said “extended period of time” would be over 5-30 minutes of time, since 5-30 minutes or less storage would be counter-productive to Adler’s suggested money-saving apparatus which uses vacuum storage for preservation of the stored ingredients for a longer time than that employed in the prior art.

If it is shown that Adler does not allow for changing the amounts of water and other ingredients to a desired coffee product combination, it would have been further obvious to have incorporated any amount of water, coffee, or other ingredients to effect a product having the attributes desired (i.e. customization). See *In re Levin*, 84 USPQ 232.

8. Claims 5, 6, 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al as applied in either one of paragraphs 5 or 7 above.

In view of claims 9-15 being directed to an apparatus, the apparatus of Adler et al would be capable of producing such ranges of brew solids through change in the amount of dilution water employed. Even though Adler et al does not specifically disclose the ranges and particular coffee claimed, the following should be noted.

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault , 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young , 25 USPQ 69 (CCPA 1935) (as restated in In re Otto , 136 USPQ 458, 459 (CCPA 1963).

Although Adler does not disclose the apparatus as having an upper limit on the length of time for delaying dilution as called for in instant claims 5 and 6, such timing would have been obvious to have modified in the apparatus of Alder as matter of preference. If claims 5 and 6 are considered as method claims, determination of such an upper limit would have been well within the purview of a skilled artisan, and, absent a showing of unexpected results (i.e. after 24 hours as opposed to before), it would have been obvious to one having ordinary skill in the art at the time of the invention to have arrived at such time as a matter of preference depending on cost involved, time constraints, apparatus timing constraints, etc.

The following addresses claims 9-15 (as well as 5 and 6) in the event that same were intended to be method claims. It would have been further obvious to have incorporated any amount of water, coffee, or other ingredients to effect a product

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desired and to have arrived at the particular brew solid amounts as called for in the instant claims as a matter of preference depending on the particular taste desired, for example, and to have achieved the particular combination of amounts (including brew solids) through routine experimental optimization.

Response to Arguments

9. Applicant's arguments filed 11/9/04 have been fully considered but they are not persuasive. Applicant argues that Adler does not teach a delay in mixing, filtering, and/or dilution in a time period of five minutes to 48 hours. It is considered inherent that the phrase of "extended period of time" (with respect to a dilution step) in Adler would include a range of well beyond a 5 minute or even 30 minute range of time. Applicants have not shown that "extended period of time" is limited from overlapping the time range called for in the instant claims.

All other arguments have been addressed in view of the rejections above.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

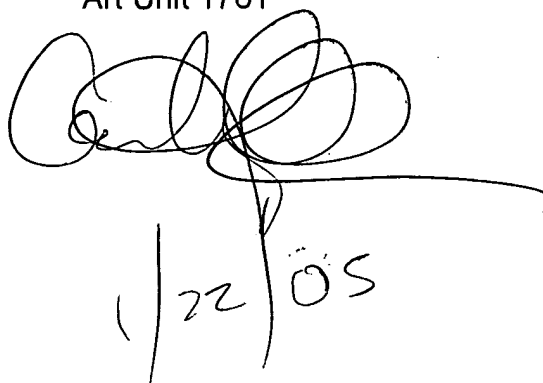
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
Primary Examiner
Art Unit 1761

Anthony Weier

January 22, 2005



1/22/05